

REMARKS

The present application contains claims 1-316, the status of which is as follows:

- (a) Claims 1-276 and 302-315 have been canceled without prejudice.
- (b) Claims 277-279, 285-286, and 290 have been currently amended.
- (c) Claims 280-284, 287-289, and 291-301 were previously added.
- (d) Claim 316 is new.

No new matter has been added. Reconsideration is respectfully requested.

The Applicant thanks Examiner Natnithithadha for the courtesy of a personal interview with the Applicant's representative, Sanford T. Colb (Reg. No. 26,856), held in the USPTO on January 16, 2007. At the interview, Mr. Colb suggested amending independent claim 277 to recite a "hollow tube" that is soldered "directly" to the circuitry. The Examiner agreed that such amendment appears to overcome the rejection under 35 U.S.C. 102(b) over US Patent 4,730,389 to Baudino et al. The Examiner indicated that he will perform an additional search based on the amended claims.

*Rejections under 35 U.S.C. 102(b) over Baudino*

Claims 277-279, 287, 288, and 291-301 were rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,730,389 to Baudino et al. While not necessarily agreeing with these rejections, the Applicant has amended independent claim 277 to recite a "hollow tube" that is soldered "directly" to the circuitry. As mentioned above, in the interview with Mr. Colb the Examiner agreed that this amendment appears to overcome Baudino. This amendment is supported by at least Fig. 3A (which shows that stainless steel cylinder 130 is directly soldered to conductive element 126 of the circuitry, by a solder joint 132) and the following excerpts from the specification as originally filed: "Thus, a stainless steel cylinder 130 is mechanically coupled to the end of each MP35N wire, for example via crimping (Fig. 3B), so as to achieve good electrical contact therewith, and the cylinder is subsequently coupled to conductive elements 126 by a solder joint 132, . . ." (p. 26, lines 8-13). "In a preferred embodiment, the connector includes a hollow tube. . ." (p. 16, lines 4-5). As is clear from context, this "hollow tube" is a generalization of "cylinder 130."

Baudino describes an implantable enclosure for electronics. The mechanical elements of the enclosure are adapted to facilitate the use of welding to provide a hermetic seal for the enclosure. In the office action dated November 1, 2006, the Examiner argued that Baudino teaches an apparatus that includes "an electrically-conductive connector (capsule adapter, which includes welded sleeve 286 along with wire 248) 268, which is soldered to the circuitry."

The Applicant respectfully submits that claim 277, as amended, is patentable over Baudino. The apparatus recited in claim 277, as amended, accomplishes with a single element (the hollow tube) that which Baudino accomplishes with two elements (welding sleeve 286 and wire 247). The use of a single element is non-trivial, in part because element size is a consideration in implantable devices. The use of a single element as recited in claim 277 provides a technique for nearly directly coupling MP35N wire to circuitry, using only about the same amount of space on the circuitry that would be used by direct soldering of the wire to the circuitry (if such direct soldering were possible). As illustrated in Fig. 6 of Baudino, Baudino's coupling technique uses about three times more space than the technique recited in claim 277. The Applicant thus submits that claim 277, as amended, is novel over Baudino, recites a meaningful difference from Baudino, and is not obvious in light of Baudino. Claims 278-279, 287, 288, and 291-301 directly or indirectly depend from claim 277, and are also allowable, being of narrower scope than the allowable independent claim from which they depend.

The Applicant notes that the phrase "soldered directly to the circuitry," recited in claim 277, includes within its scope embodiments in which the hollow tube is coated, and the coated hollow tube is soldered directly to the circuitry. Such a coating is recited in dependent claims 285 and 316. Claim 316 is new, and is supported by at least the following excerpt from the specification as originally filed: "To obtain improved electrical conduction, cylinders 130 are preferably coated with gold prior to soldering" (p. 26, lines 16-18).

Although, as noted above, dependent claim 278 is allowable because it is of narrower scope than allowable claim 277 from which it depends, the Applicant submits that claim 277 would be independently patentable, even if claim 277 were to be found

invalid. The Examiner argued that Fig. 6 of Baudino shows that capsule adapter 268 is crimped to lead wire 274. The Applicant respectfully submits that Fig. 6 of Baudino does not show such crimping, as can be seen by comparing the shape of capsule adapter 268, as shown in Fig. 6 of Baudino, with the shape of "crimps 264" (Baudino's term) of Fig. 5 of Baudino. As can be seen in Fig. 5, Baudino uses a particular shape to show crimping, and this shape is absent from the relevant portion of his Fig. 6. Furthermore, even if it were to be granted for the sake of argument that Baudino's capsule adapter 268 is crimped to lead wire 274, there would still be no indication in Baudino that his welding sleeve 286 is crimped to lead wire 274. The hollow tube recited in claim 278 is parallel to Baudino's welding sleeve 286, and not to Baudino's capsule adapter 268.

*Rejections under 35 U.S.C. 103(a)*

Dependent claims 280-285, 289, and 290 were rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino in view of US Patent 5,851,226 to Skubitz et al. Dependent claim 286 was rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino in view of US Patent 6,129,658 to Delfino. The Applicant submits that claims 280-285, 286, 289, and 290 are allowable, being of narrower scope than allowable independent claim 277 from which they directly or indirectly depend.

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

Respectfully submitted,

CLIFFORD J. MASS  
LADAS & PARRY LLP  
26 WEST 61ST STREET  
NEW YORK, NEW YORK 10023  
REG. NO.30,086(212)708-1890